

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Shelley D. Minteer et al.

Art Unit: 1795

Serial No.: 10/617,452

Patent No.: 7,638,228 B2

Filed: July 11, 2003

Confirmation No.: 4859

For: ENZYME IMMOBILIZATION FOR USE IN BIOFUEL CELLS AND SENSORS

Examiner: Angela J. Martin

February 26, 2010

COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

SIR:

REQUEST FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT
PURSUANT TO 37 C.F.R. 1.705

Applicants submit the following petition requesting reconsideration of the patent term adjustment determination and setting forth Applicants' asserted adjustment.

In response to the December 29, 2009, issuance for the above-referenced patent, Applicants respectfully request reconsideration of the patent term adjustment determination. Pursuant to 37 CFR § 1.705(b) and/or (d), Applicants submit the following statement of facts in support of this request for reconsideration.

The application was filed on July 11, 2003. The first Office action on the merits was mailed on June 30, 2006, which is six hundred fifty seven (657) days after the fourteen (14) month due date for the mailing of a first office action on the merits. A response to the Office action mailed April 3, 2007 was filed on July 5, 2007, (the first business day after the due date) and a supplemental response was filed September 18, 2007, which is eighty one (81) days after the initial response was filed. A response to the Office action mailed June 30, 2008, was filed on October 30, 2008, thirty (30) days after the 3 month shortened period for a response to an Office action. The second Office action was mailed on February 21, 2008, which is within the four (4) month period for reply by the Office. A final Office action was mailed February 5, 2009, and a request for continued examination was filed on July 6, 2009, (the first business day after the due

date), sixty two (62) days after the three (3) month shortened statutory period for response. A notice of allowance was mailed September 23, 2009. All other Office actions were mailed and responses to Office actions were filed within the statutorily required time periods. The Issue Fee was paid November 10, 2009, which was within the three (3) month period for payment of an Issue Fee. The patent issued on December 29, 2009, which was within the four (4) month period for the Office to issue patent. Thus, the total Patent Term Adjustment under 37 CFR § 1.705(b) was six hundred fifty seven (657) minus one hundred seventy three (173) days, which is four hundred eighty four (484) days.

According to 35 U.S.C. 154, the term of a patent may be extended by one day for every day of PTO delay specified by 35 U.S.C. 154(b)(1)(A) (“Period A” delay) and by one day for every day of delay beyond three years after the application filing date that it takes for the PTO to issue a patent as specified by 35 U.S.C. 154(b)(1)(B) (“Period B” delay). These two periods of delay are lessened by one day for every day of Applicant delay as specified in 35 U.S.C. 154(b)(2)(C); moreover, to the extent the Period A and Period B delays overlap, the period of any adjustment may not exceed the actual number of days issuance of the patent is delayed. 35 U.S.C. 154(b)(2)(A).

In the particular instance, the Period A delay on the part of the Office was six hundred fifty seven (657) days. The Period B delay on the part of the Office was one thousand two hundred sixty eight (1268) days (i.e., the period of time from three years after the filing of the application (July 11, 2006) to the issuance of the patent on December 29, 2009. Thus, the result is an Office delay of one thousand nine hundred twenty five (1925) days.

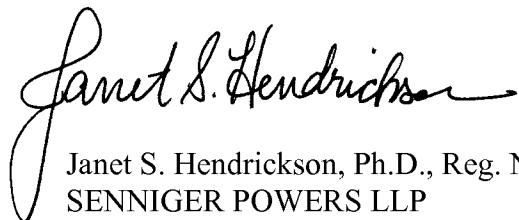
The total delay of applicants was the sum of one hundred seventy three (173) days (for filing various responses to Office actions after the statutory 3 month period) and one hundred seventy seven (177) days (the time elapsed between filing the request for continued examination on July 6, 2009 and issuing the patent on December 29, 2009) for a total delay of three hundred fifty (350) days. Therefore, subtracting Applicants’ delay of three hundred fifty (350) days from the Office’s delay of one thousand nine hundred twenty five (1925) results in a patent term extension of one thousand five hundred seventy five (1575) days, or one thousand ninety one (1091) days greater than the patent term adjustment of four hundred eighty four (484) indicated in the issued patent.

Based upon a review of the Patent Application Information Retrieval (PAIR) database regarding the subject application, it appears that the Office did not add the Period B delay of one thousand two hundred sixty eight (1268) to the total Office delay, presumably assuming this Period B delay to overlap with the Period A delay. However, according to the recent decision of Wyeth v. Dudas, 88 U.S.P.Q. 2d, 1538 (D.D.C. 2008) and its affirmance at the Federal Circuit (Appeal No. 2009-1120, January 7, 2010), the Office's Period B delay does not overlap with the Office's Period A delay, because the Period B delay does not occur within the period of three years after the filing of the application in which the Period A delay occurred. Accordingly, the Office's determination of its own delay of six hundred fifty seven (657) days is inaccurate, falling short by one thousand two hundred sixty eight (1268) days.

Applicants submit that the patent term adjustment should be increased by one thousand ninety one (1091) days. This correction should bring the total patent term adjustment to one thousand five hundred seventy five (1575) days. Applicants respectfully request a correction in the patent term adjustment to reflect the same.

Applicants' provide a \$200.00 fee under 37 C.F.R. §1.18(e) herewith. The Commissioner is hereby authorized to charge any underpayment or credit any overpayment to Deposit Account No. 19-1345.

Respectfully submitted,



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JSH/clp